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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,243	04/24/2001	Krzysztof Masternak	010830-117	3494

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EXAMINER

VANDERVEGT, FRANCOIS P

ART UNIT PAPER NUMBER

1644

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>09/840,243</p>	<p><b>Applicant(s)</b></p> <p>MASTERNAK ET AL.</p>	
	<p><b>Examiner</b></p> <p>F. Pierre VanderVegt</p>	<p><b>Art Unit</b></p> <p>1644</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

This application is a continuation of U.S. Application Serial Number PCT/EP99/08026.

#### *Priority*

1. Acknowledgment is again made of applicant's claim for foreign priority based on an application filed in Europe on 10/24/1998. It is noted, however, that applicant has still not filed a certified copy of the European application as required by 35 U.S.C. 119(b). Applicant's intent to file said certified copy, as asserted at page 3, section 1, of the remarks filed February 24, 2004 is acknowledged. However, until said submission is perfected, the objection stands.

Claims 2, 4-61 and 63-76 have been canceled.

Claims 1, 3 and 62 are currently pending and are the subject of examination in the present Office Action.

In view of Applicant's amendment filed February 24, 2004 no outstanding ground of rejection is maintained. The following represents a reinstated ground of rejection and this Office Action is made NON-FINAL.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 1, 3 and 62 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 5,989,863 to Tang et al. (issued November 23, 1999, filed October 14, 1998; A on form PTO-892 mailed March 25, 2003, of record).

The '863 patent teaches and claims (claim 1 in particular) a human ankyrin family protein (designated ANFP) that consists of an amino acid sequence (SEQ ID NO:1) identical to the amino acid sequence of the instantly disclosed SEQ ID NO:2, (Abstract, Figures 1 and 2, and column 3 in particular). While the '863 patent does not teach that the protein is capable of restoring the MHC-II expression in cells from MHC-II deficiency patients in complementation group B and that it comprises all or part of the amino acid sequence of instant SEQ ID NO:2, the referenced protein would inherently possess said properties because the amino acid sequence of SEQ ID NO: 1 of the '863 patent is identical to that of the instantly claimed SEQ ID NO: 2. Applicant is reminded that further characterization of an otherwise old product does not distinguish the product from the prior art because the product itself remains the same, regardless of the method of characterization. See *Ex parte* Novitski (Bd. Pat. App. & Int.) 26 USPQ2d 1389. The prior art teaching anticipates the claimed invention.

Applicant's declaration filed September 8, 2003 stating that the claimed invention was conceived prior to the October 14, 1998 filing date of the '863 patent is acknowledged. However, Applicant cannot use a 37 CFR § 1.131 declaration to swear behind a claimed invention in an issued U.S. Patent. Applicant must provoke an interference against the claimed invention by a filing in accordance with 37 CFR § 1.608. Applicant is reminded, however, that priority to the filing date of foreign priority application EP 98 120085.0 has not been perfected by the filing of a certified copy. Therefore, at present, the earliest filed application that Applicant can presently rely upon the date of filing of is PCT/EP99/08026, which was filed on October 22, 1999. Because the filing date of the '863 patent, which is October 14, 1998, is more than six months earlier than the filing date of PCT/EP99/08026, it is not likely that interference proceedings would be initiated.

### Conclusion

3. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571) 272-0852. The examiner can normally be reached on M-Th 6:30-4:00; Alternate Fridays 6:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Pierre VanderVegt, Ph.D. *R*  
Patent Examiner  
May 3, 2004

*Pat J. Nolan*  
PATRICK J. NOLAN, PH.D.  
PRIMARY EXAMINER  
*5/3/04*